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IN THE

Supreme Court of the United States

October Term, 1935.

No. 356

WINE RAILWAY APPLIANCE COMPANY,
Petitioner,

v.

ENTERPRISE RAILWAY EQUIPMENT COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

PETITION.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

The Wine Railway Appliance Company respectfully prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Sixth Circuit, entered in the above-entitled case on May

14, 1935 (R. p. 225), reversing in part a decree of the District Court of the United States for the Northern District of Ohio, Western Division (R. p. 169). A certified transcript of the record in the case, with the necessary additional copies thereof, has been filed in compliance with Rule 38 of the rules of this Court.

Summary and Short Statement.

The petitioner is a corporation organized under the laws of Ohio; the respondent is a corporation organized under the laws of Illinois. In 1922 the respondent instituted a suit against the petitioner for infringement of letters patent; and on April 25, 1923, the petitioner filed a counterclaim for an injunction and damages for the infringement by respondent of several United States letters patent, owned by petitioner, among them patent No. 1,434,953, Byers W. Kadel, dated November 7, 1922. From a decree of the District Court dismissing both the bill and the counterclaim, the petitioner alone appealed. The Circuit Court of Appeals for the Sixth Circuit reversed the lower Court in respect to claim 2 of petitioner's patent No. 1,434,953, and held it to be valid and infringed (R. p. 2; 25 F. (2d) 236). Claim 3, held invalid, was disclaimed by petitioner.

An accounting was had. On June 17, 1932, the Master filed his report, finding that the petitioner was entitled to recover the sum of $18,003.63 as a result of the infringement, this sum representing the profits made by the respondent and the damages accruing to the petitioner before as well as subsequent to the filing of the counterclaim, and including interest from the date of the Master's report, together with costs (R. p. 14).

On June 15, 1933, a decree was entered by the District Court confirming the report of the Master (R. p. 169).

Before the Master the respondent filed two statements of account, one (R. p. 10) beginning November 7, 1922, the date of issue of the Kadel patent No. 1,434,953, and another

(R. p. 12) beginning April 25, 1923, the date of filing of the counterclaim by petitioner; and the respondent contended before the Master and the District Court that, under the provisions of Section 4900 R. S., it should account only for profits and damages accruing after the filing of the counterclaim, there having been no previous notice to respondent of the patent and the infringement thereof. The Master and the lower Court (R. pp. 21, 22, 168 and 173) held that Section 4900 R. S. did not apply to this case, because, as the proofs show and the Master found (R. p. 23), no articles were ever manufactured, used or sold under patent No. 1,434,953.

On September 13, 1933, the respondent appealed from the decree of the District Court confirming the report of the Master (R. p. 176). On the appeal the Circuit Court of Appeals held (R. p. 226; 77 F. (2d) 159, 161) that Section 4900 R. S. "requires the patentee or his assignee who does not make or vend the (patented) article to give notice of the patent (to an infringer) and limits the recovery for infringement thereof to damages sustained thereafter" (R. p. 227); and the decree of the District Court was reversed and "the cause remanded for the entry of a decree in an amount representing the profits derived by the appellant (respondent)" from infringements committed "after notice was given (to respondent) by the filing of the counterclaim, less the income taxes paid by the appellant (respondent) thereon" (R. p. 228). The decree remanding the cause in accordance with this opinion was entered May 14, 1935 (R. p. 225).

The pertinent facts involved are summarized as follows:

(a) Neither the petitioner nor anyone else with its consent manufactured or vended under the patent in suit.

(b) No actual notice of the patent was given to respondent by petitioner prior to the filing of its suit for infringement (the filing of its counterclaim).

(c) The accounting period was divided into two parts, (1) for infringement committed after actual notice of the patent (date of filing counterclaim by petitioner) for which there was an award of the entire profits, and (2) for infringement committed prior to the actual notice to respondent for which a recovery of profits and damages was denied.

Question Presented.

The sole question is:

Whether, as a condition precedent to the recovery of any damages for infringement, Section 4900 R. S. when properly interpreted imposes on a patentee (or patent owner) who has never made or vended the patented article the same onus of giving to an infringer actual notice of the patent infringed and the infringement thereof that it places upon a patentee (or patent owner) who has actually made or vended the patented article but who has failed to properly mark the same with the required patent notice.

Reasons for Granting the Writ.

1. The Court of Appeals below has decided an important question of Federal law which has not been, but should be, settled by this Court; and has decided it in a way probably in conflict with the intent and language of the only decision of this Court interpreting 4900 R. S., *Dunlap* v. *Schofield*, 152 U. S. 244, wherein it is stated, pp. 247-248—

> "The clear meaning of this section is that the patentee or his assignee, *if he makes or sells the article patented*, cannot recover damages against infringers of the patent, unless he has given notice of his right, either to the whole public by marking his article 'patented,' or to the particular defendants by informing them of his patent and of their infringement of it."

Although in the *Dunlap* v. *Schofield* case the facts did not require an application of the statute to the present question, the construction of the statute there given by this Court is contrary to the one given to it by the Court of Appeals below.

2. The Court of Appeals below has decided an important question of Federal law upon which there is considerable diversity of judicial opinion and which should be definitely settled by this Court.

(a) The Court of Appeals below itself points out this diversity, saying (R. p. 226; 77 F. (2d) 159, 160)—

> "There is a diversity of opinion as to whether this statute applies to a suit for damages for infringement of a patent for a device which has never been made or sold by the patentee or its licensees. Campbell v. Mayor, etc., 81 Fed. 182, 184; Ewart Mfg. Co. v. Baldwin Cycle-Chain Co., 91 Fed. 262, and Olsson v. United States, 72 Ct. Cl. 72, 102, 103, *hold that it does not*, while Son v. Pressed Steel Car Co., 21 Fed. (2d) 528 (D. C. N. Y.) and Van Meter v. United States, 47 Fed. (2d) 192, 196 (C. C. A. 2) *hold that it does.*" (Emphasis ours.)

As is here the case, all of the decisions cited in the above quotation concern patented *articles*, the decision of the Court of Claims in *Olsson* v. *United States* (72 Ct. Cl. 72) being reaffirmed and more fully discussed on motion for new trial (72 Ct. Cl. 102, 103)

The Court of Appeals for the Fourth Circuit in *American Ornamental Bottle Corp.* v. *Orange-Crush Co.*, 76 F. (2d) 969, also points out and discusses the diversity of opinion on this subject.

(b). There is also a diversity of opinion respecting the application of Section 4900 R. S. to *process* patents, which, so far as marking under this statute is concerned, are anal-

ogous to article patents under which there has been no making or vending. Thus

(1) The following cases hold that Section 4900 R. S. *does not apply* to process patents:

Carnegie Steel Co. v. *U. S. Mitis Co.*, 90 F. 829 (C. C. A. 3), affirming *U. S. Mitis Co.* v. *Carnegie Steel Co.*, 89 F. 206;
U. S. Mitis Co. v. *Carnegie Steel Co.*, 89 F. 206;
U. S. Mitis Co. v. *Midvale Steel Co.*, (E. D. Pa.) 135 Fed. 103;
Wagner v. *Corn Products Refining Co.*, (Dist. N. J.) 28 Fed. (2d) 617.

(2) The following case holds that Section 4900 R. S. *does apply* to process patents:

Parker Rust Proof Co. v. *Ford Motor Co.*, (S. Div. Eastern Dist. Mich.) 23 Fed. (2d) 502;

See also:

Churchward Co. v. *Bethlehem Co.*, (E. D. Pa.) 262 Fed. 438.

3. The language of Section 4900 R. S. is capable of two interpretations as the various decisions of the Courts (*ante* pp. 5-6) show, and its proper interpretation should be determined by this Court for the guidance of all owners of patents for inventions. The denial to non-manufacturing patentees of the right to recover damages and profits for infringement prior to the giving of actual notice charging the infringement is contrary to the intent of Section 4900 R. S. and is a matter of such wide public interest and affects so many patentees and owners of rights under patents as to call for review by this Court of the decision of the Court below in this respect.

WHEREFORE, your petitioner prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the

Sixth Circuit, commanding said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record of all the proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals denying the recovery of profits for the infringing period prior to the date of actual notice of patent be reversed; and that the petitioner be granted such other and further relief as may seem proper.

WINE RAILWAY APPLIANCE COMPANY,
Petitioner,

GILBERT P. RITTER,
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Attorneys for Petitioner.

BRIEF IN SUPPORT OF THE PETITION.

Opinions Below.

The opinion (not reported) of the District Court of the United States for the Northern District of Ohio, Western Division, on the question here involved, appears at pages 167 to 169 of the Record; and the opinion of the United States Circuit Court of Appeals for the Sixth Circuit (R. 226) is reported in 77 F. (2d) 159. The report of the Master on the accounting, which was confirmed by the District Court, appears at pages 14 to 23 of the Record.[1]

Jurisdiction.

The decree below was entered on May 14, 1935 (R. 225). The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925; U. S. C. Title 28, Section 347 (a).

Statement of the Case.

The principal facts pertinent to the single question involved are sufficiently stated in the Petition, *ante*, pages 2 to 4.

Specification of Errors.

(1) The Circuit Court of Appeals for the Sixth Circuit erred in finding and holding that, there having been no making or vending of any article under the petitioner's patent, Section 4900 R. S. precludes the recovery by petitioner of profits accruing prior to the giving to respondent of actual notice of the patent and its infringement.

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[1] The opinions on the validity and infringement of the patent in suit, which preceded the accounting proceedings in which the interpretation of Section 4900 R. S. was brought into question, are: The opinion of the District Court of the United States for the Northern District of Ohio, Western Division, not reported; and the opinion of the Circuit Court of Appeals for the Sixth Circuit on appeal from the decree of the District Court dismissing petitioner's counterclaim, reported in 25 F. (2d) 236.

(2) The said Court erred in reversing and in not affirming the decree of the District Court awarding to petitioner the profits made by respondent by reason of its infringement during the period prior to the date of actual notice to respondent charging infringement of the patent in suit.

Summary of Argument.

The points of argument follow the reasons relied upon for the allowance of the writ and are conveniently summarized in the petition under "Reasons for Granting the Writ", *ante*, pp. 4-6.

Statute Involved.

The statute involved is Section 4900 of the Revised Statutes and is as follows:

> "It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word 'patented,' together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice to make, use, or vend the article so patented."[1]

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[1] This is the form of Section 4900 R. S. as it was at the time this suit was instituted and at the time the counterclaim was filed. It has since been amended by the Act of February 7, 1927 (44 Stat. L. 1058) to provide that the marking of the patented article shall be by patent number rather than by the date of issue of the patent. Thus amended it is Title 35, Section 49, U. S. Code.

ARGUMENT.

POINT I.

The decision of the Court below is based on an interpretation of Section 4900 R. S. which apparently is in conflict with the interpretation placed upon that statute by this Court.

The Court below has held that Section 4900 R. S. applies to all patentees "whether they do or do not make or vend the article" and that, therefore, it "requires the patentee or his assign who does not make or vend the article to give notice of the patent and limits the recovery for infringement thereof to damages sustained thereafter" (77 F. (2d) 159, 161). Such interpretation of the statute is in apparent conflict with the interpretation given it by this Court in *Dunlap* v. *Schofield,* 152 U. S. 244, where, at pages 247-248, it is said:

> "The clear meaning of this section is that the patentee or his assignee, *if he makes or sells the article patented,* cannot recover damages against infringers of the patent, unless he has given notice of his right, either to the whole public by marking his article 'patented,' or to the particular defendants by informing them of his patent and of their infringement of it." (Emphasis ours).

POINT II.

The interpretation of Section 4900 R. S. has been the subject of considerable discussion in the decisions of the courts and a diversity of opinion has arisen as to whether it applies to patentees who do not make or vend the patented article. This diversity of opinion should not be permitted to continue.

The decision of this Court in *Dunlap* v. *Schofield, supra,* has been cited in support of the holding that 4900 R. S. does not apply where there has been no making or vending under the patent, in the following cases:

Campbell v. *Mayor of New York* (S. D. N. Y.), 81 F. 182;
Ewart v. *Baldwin Co.* (Dist. Mass.), 91 F. 262;
Wagner v. *Corn Products Refining Co.*, 28 F. (2d) 617 (Dist. N. J.);
Van Meter v. *United States* (Dist. N. Y.), 37 F. (2d) 111, 113.
Olsson v. *United States*, 72 Ct. Clms. 72, 9 Pat. Q. 111; new trial denied, 72 Ct. Clms. 103, 11 Pat. Q. 13.

The case last cited is the latest pronouncement on the subject. In its decision the Court of Claims said:

> "The clear meaning of § 4900 R. S., is that if the patented articles are *made* and *sold*, and not marked as required, the patentee or his assignee cannot recover damages against the infringers of the patent. *The consequence imposed by this section is not intended for those who cannot perform the duty required because there has been no manufacture or sale of the article, but for those only who could have performed it and did not.*" (Emphasis ours.)

It has been decided that Section 4900 R. S. does not apply to a process patent, since the process is not susceptible of marking, in the following cases:

Carnegie Steel Co. v. *U. S. Mitis Co.*, 90 F. 829 (C. C. A. 3), affirming *U .S. Mitis Co.* v. *Carnegie Steel Co.*, 89 F. 206;
U. S. Mitis Co. v. *Midvale Steel Co.*, 135 F. 103 (E. D. Pa.);
Wagner v. *Corn Products Refining Co.*, 28 F. (2d) 617 (Dist. N. J.).

However, one case has been found, *Parker Rust Proof Co.* v. *Ford Motor Co.*, 23 F. (2d) 502 (S. D. E. D. Mich.), which holds that Section 4900 R. S. does apply to process patents. See also *Churchward Co.* v. *Bethlehem Co*, (E. D. Pa.) 262 F. 438.

It would seem that in respect to the application of the statute thereto, process patents are analogous to article

patents under which there has been no making or vending, for in neither case is there any tangible thing susceptible of being marked "Patented".

In addition to the decision of the Court of Appeals in the instant case, the following four cases have been found holding that Section 4900 R. S. applies to all patentees regardless of whether the patented articles have ever been made or sold under the patent:

Churchward International Steel Co. v. *Bethlehem Steel Co.*, 262 F. 438 (E. D. Pa.);
Son v. *Pressed Steel Car Co.* 21 F. (2d) 528 (S. D. N. Y.); and
Van Meter v. *United States*, 47 F. (2d) 192 (C. C. A. 2nd).

See also:

Flat Slab Patents Co. v. *Northwestern Glass Co.*, 281 F. 51 (C. C. A. 8th).

The *Churchward* case was decided by Judge Dickinson of the Eastern District of Pennsylvania and reversed by the Court of Appeals for the Third Circuit on other grounds (268 F. 361). He states (p. 443) that the statute "applies to all patentees, and is not limited to those who make and vend patented articles", but he fails to observe that recovery of damages is not barred in every suit for infringement, where the defendant was not duly notified, but only when the defendant is under an *obligation to mark* (*i. e.* when the patented articles are being made or vended) and has *failed to mark* the patented articles. No authority is cited in the opinion in support of his ruling.

The case of *Son* v. *Pressed Steel Car Co.* was decided by Judge Thacher of the Southern District of New York. He relied upon the *Churchward* case and the *Flat Slab* case and also upon *American Caramel Co.* v. *Thomas Mills & Brother*, 162 F. 147, a decision by the Court of Appeals for the Third Circuit, which is not in point. It appears from

the opinion in the *American Caramel Co.*[1] case that the plaintiff had made the patented machines and used them in its own business, and had failed to mark the machines so made. That was not the situation in the *Son* case nor is it the situation here under consideration. In the *Son* case, as well as in the instant case, there was no making or vending of the patented article.

The case of *Van Meter* v. *United States,* 47 F. (2d) 192, was decided by the Court of Appeals for the Second Circuit on the authority of the *American Caramel Co.* case, in which case plaintiff had made the patented machines and had failed to mark the machines so made, a situation not justifying its acceptance by the Court of Appeals for the Second Circuit as authority for the holding that (p. 196) "The inventor who does not manufacture must give notice of infringement."

The *Flat Slab* case was decided by the Circuit Court of Appeals for the Eighth Circuit on the authority of Judge Dickinson's opinion in the *Churchward* case. However, in this case it appeared that, while the patentee himself had not manufactured or sold the patented structure, a large number of licenses had been granted and many licensees had paid royalties for buildings constructed and used under the patent. In this connection, the Circuit Court of Appeals for the Eighth Circuit, after discussing many cases and referring particularly to the decision of Judge Putnam in *Ewart Manufacturing Co.* v. *Baldwin Cycle Chain Co.,* 91 F. 262, said (p. 54):

> "The case that Judge Putnam was considering was one where the patentee had not licensed any person to make, use or sell the patented article under patent No. 237,771. The uncontradicted evidence of the case at bar shows that the plaintiff had issued a number of licenses under its patent and that many licensees had

[1] See also the lower court decision in this case, reported in 138 F. 142; and also the former decision of the Court of Appeals in the same case, reported in 149 F. 743.

paid royalties for buildings constructed and used. So Judge Putnam's decision would not control the present case, because the facts are not the same."

While the *Flat Slab* case has been referred to (*Son* v. *Pressed Steel Car Co.*, 21 F. (2d) 528, S. D. N. Y.) as authoritatively holding that Section 4900 R. S. applies to all patents, whether manufactured under or not, it is clear from the foregoing that the decision cannot be so interpreted. The decision of Judge Putnam from which Judge Carland distinguishes the *Flat Slab Patents Co.* case is the case of *Ewart Co.* v. *Baldwin Co., supra,* wherein the plaintiff never made, used or sold or licensed anyone else to make, use or sell devices under the patent, and in which Judge Putnam, after referring to *Dunlap* v. *Schofield, supra,* and *Coupe* v. *Royer,* 155 U. S. 565, said:

> "There is nothing in the phraseology of the statute, as well as no expression in the opinions of the Supreme Court referred to, which will enable us to apply to circumstances like those at bar, *under which the patent has lain absolutely dormant,* a requirement in reference to marking patented articles, which, under those circumstances, becomes physically impossible."

It will be noted that Judge Carland, in the *Flat Slab Patents* case, does not disapprove the finding of Judge Putnam in the above-mentioned case, but distinguishes the circumstances of the *Flat Slab Patents* case therefrom by stating that in the latter licenses were granted under the patent and that buildings were constructed thereunder and used. Therefore, the *Flat Slab Patents* case is merely authority for holding that Section 4900 R. S. applies where licenses have been granted and articles made thereunder. Anything in the decision to the contrary is merely dictum.

Not only has the diversity of decisions of the various courts on the proper interpretation to be given to Section 4900 R. S. where there has been no making or vending un-

der the patent (*ante* page 5) been emphasized by the Court below, but such diversity has also been recognized and discussed at length without definite determination by the Fourth Circuit Court of Appeals in the recent case of *American Ornamental Bottle Corp.* v. *Orange-Crush Co.*, 76 F. (2d) 969.

In that case the Court notes that the interpretation of Section 4900 R. S. has been "the subject of considerable discussion in the decisions of the courts" and points to the diversity of opinion that has arisen on the question. The case cites decisions supporting the opposing views, but there is no determination of the proper interpretation of the statute, the case being decided on grounds making it immaterial which of the conflicting views is accepted.

It is submitted that uniformity of decision in the Courts of the United States is desirable and that this Court should interpret Section 4900 R. S. to the end that it may be authoritatively determined whether the requirement of notice of infringement as a condition of the recovery of damages is limited to cases of patentees who, through themselves or their licensees, make or vend the patented article, or includes all patentees, whether manufacturing articles under the patent or not.

POINT III.

Section 4900 R. S. can only apply to a tangible thing, that is to say, a thing which has been made or vended; otherwise, some of the words used in the statute have no antecedent and are meaningless and the statute is unintelligible.

Section 4900 R. S., as in force in 1922, reads as follows:

> "It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons MAKING OR VENDING ANY PATENTED ARTICLE for or under them to give sufficient notice to the public that the SAME (*the article so made or vended*) is patented; either

by fixing THEREON (*on the article*) the word 'patented', together with the day and year the patent was granted; or when, from the character of the ARTICLE, this cannot be done, by affixing to IT (*the article*), or to the package wherein one or more of THEM is enclosed, a label containing the like notice; and in any suit for infringement, by the party FAILING SO TO MARK, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend THE ARTICLE SO patented." (Parenthetical insertions ours.)

As will be observed, this section is applicable to three classes of persons, namely

(1) To "patentees";
(2) To the "assigns and legal representatives" of the patentees; and
(3) To "all persons making or vending any patented article for or under them"; that is, licensees of either the patentees or their assigns or legal representatives;

and it provides that it shall be the duty of such persons to

"give sufficient notice to the public that the SAME (*the article so made or vended*) is patented either by fixing THEREON (*on the article*) the word 'PATENTED', together with the day and year the patent was granted; or when, from the character of the ARTICLE (*the one manufactured and sold*), this cannot be done, by affixing to IT (*the article*), or to the package wherein one or more of THEM (*the article*) is enclosed, a label containing the LIKE NOTICE;" etc.

A careful reading of the foregoing statute will make it clear that it applies and can only apply to a *tangible thing*, that is to say, the thing which has been *made* or *vended*; otherwise, words subsequently used in the Section have no antecedent and are meaningless. In other words, the plain language of the statute is that notice shall only be given

where the "patented article" is "made or vended". It seems obvious that Congress, in framing this section of the patent statutes, intended merely to protect the public against owners of patents who *made or vended* the patented article and *failed* to give notice to the public that said article was patented.[1] That this is so appears not only from the language of the statute itself, but from the fact that there are certain patent owners,—those who own *process* patents, which cover intangible things which, of course, are incapable of being marked—who could not possibly comply with the provisions of the statute if it were intended to apply to all patentees indiscriminately.

If the statute were interpreted to apply to "all patentees" it would read:

> "It shall be the duty of all patentees * * * to give sufficient notice to the public that the *same* is patented; either by fixing thereon the word 'Patented', together with the day and year the patent was granted",

and in such case the word "same" has no antecedent. This word, obviously, can only refer back to the "patented article" being made or vended. This Court held to that effect in *Sessions* v. *Romadka,* 145 U. S., 29, where, in interpreting R. S. 4900, and in quoting from the section, it stated (p. 49)—

> " 'To give sufficient notice to the public that the same' (*that is, the article*) 'is patented'; "

It would be absurd to say that the word "same" had reference to the noun "patentees".

The same situation exists as regards the word "thereon", which likewise would only sensibly refer back to the article

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[1] Section 4901 R. S., which forbids *false* marking of *unpatented* articles, is intended to prevent injury to the public through false marking to mislead persons into an opinion that they have no right to make other specimens of the thing falsely marked as being patented. It is complemental to Section 4900 R. S., which, by requiring that a patented article shall be marked, gives the public notice that other specimens of the thing marked as being patented cannot freely be made.

being made or vended. The only rational meaning of the statute, therefore, is that it is intended to apply to some tangible thing, *i. e.* "patented article", and then only when such patented article has been made or vended, because obviously if the patented article is not being made or vended, it cannot have fixed "thereon" the patent notice which this statute contemplates.

The alternative notice provided for by the statute is limited in the same way, because the language used is that no damages shall be recovered in any suit for infringement by the party "failing so to mark". Here the section presupposes existence of articles which could have been marked, namely, articles made or vended and bars recovery only in the event that the party, who could thus have marked the article so made or vended, *failed* to do so. There cannot be a failure to mark unless there have been articles in existence susceptible of marking under the statute and if the patentee or those claiming under him have never made the patented article, they certainly cannot be said to have *failed to mark it.*

POINT IV.

The legislative history of Section 4900 R. S. shows that Congress did not intend the Statute to apply to patentees who did not make or vend a patented article.[1]

(1) Under the Act of Congress of June 27, 1866 (14 Stat. L. 74, v. 1)[2] authority was given for the appointment by the President, with the advice and consent of the Senate, of three commissioners "to revise, simplify, arrange, and consolidate all statutes of the United States, general and permanent in their nature, in force at the time such commis-

[1] In ascertaining legislative purpose, the courts may examine the source in previous legislation of the provisions in question. *U. S.* v. *Katz*, 271 U. S. 354, 40 S. Ct. 513. See also *U. S.* v. *Bowen*, 100 U. S. 508; *U. S.* v. *St. Paul M. & M. Railway Co.*, 247 U. S. 310, 38 S. Ct. 525, and *Takao Ozawa* v. *U. S.*, 260 U. S. 178, 43 S. Ct. 65.

[2] Sections 1 to 4 of this act appear in the appendix at pages 24 and 25.

sioners, may make the final report of their doings" (Sec. 1). The work of the Commissioners of Revision continued until the Revised Statutes were enacted in 1874.

(2) At the time of the Act of 1866 providing for the Commissioners of Revision, the statute in force respecting the "marking" of patented articles was Section 13 of the Act of March 2, 1861 (12 Stat. L. 249), which provided that "where an article *is* made or vended by any person under the protection of letters-patent", it was the duty of such person to mark it "patented."[1]

(3) Subsequent to the Act of 1866 authorizing and fixing the duties of the Commissioners of Revision, but before the enactment of the Revised Statutes, Congress passed the Consolidated Patent Act of 1870[2] which contained, as Section 38, a provision[3] respecting the marking of patented articles which is in the identical language that later became Section 4900 of the Revised Statutes.

The bill which became the Patent Act of 1870 was introduced at the Second Session of the 41st Congress on April 7, 1870 as House of Representatives Bill No. 1714.[4] Printed on the first page of the bill, above its title, was the notation:

> "Strike out the parts within [brackets] and insert the parts in *italics.*"

As introduced, this bill contained the following section, numbered "[37] 38," which was printed *without any words being italicized and with no* [*brackets*] except those in the first line enclosing the section number "37," as shown below:

> "Sec. [37] 38. It shall be the duty of all patentees, and their assigns and legal representatives, and of all

[1] This section (13) of the Act of March 2, 1861, ch. 88, § 13 (12 Stat. L. 249) is printed at page 25 of the appendix.

[2] Act of July 8, 1870, ch. 230; 16 Stat. L. 198.

[3] Section 38 of the Act of 1870 (16 Stat. L. 203) is printed at page 26 of the appendix.

[4] This bill (H. R. 1714) in the form in which it was introduced is to be found in the House of Representatives Library.

persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word 'patented,' together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement by the party failing so to mark, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make or vend the article so patented."

In the right-hand margin of the text of this section of the bill the following "side-note" appeared:

"Patented article to be marked.

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2 Mar., 1861, ch. 88, § 13, v. 12, p. 249"

This section of the bill was enacted in the form in which it was introduced, with the single exception that the word "use" was added so as to make the section conclude with the words "to make, use or vend the article so patented."

This bill was merely a step in the general consolidation and revision of the statutes under the direction of the Commissioners of Revision; and the language used in Section 38 was not intended to work any change in the law as expressed in Section 13 of the Act of 1861 then in force. This appears from the statement of Mr. Jenckes, Chairman of the House Committee on Patents, when reporting this bill (H. R. 1714) to the House of Representatives on April 14, 1870.[1] Mr. Jenckes stated that the bill he was reporting from the Committee on Patents was "based upon the revision of the laws relating to patents and copyrights made by the Commissioners of Revision" and that "that revisal

[1] Congressional Globe, Vol. 43, Part 5, pp. 2679-2684.

of these particular statutes was reported to this House early in this Congress and referred by the House to the Committee on the Revision of the Laws of the United States"; that "it was examined by that committee and was found to embody all the provisions of existing law"; and that the Committee on the Revision of the Laws "subsequently reported it to the House and recommended that it be referred to the Committee on Patents."[1]

Explaining the significance of the form in which the bill was printed, with some words enclosed by brackets and others in italics, Mr. Jenckes said:[2]

> "*The bill is so printed as to show the law exactly as it now is,* in the form in which it came from the hands of the commissioners of revision. *Every provision which is now in force has been printed at length* in the bill, although it is proposed to strike out by way of amendment many of them. All those which it is proposed to strike out are printed, and *the amendments,* many of which are substitutes for the parts proposed to be omitted, *are also printed separately, and in italics, so that they may be clearly distinguished from the law as it now is.*" (Emphasis ours)

It thus appears, both from the fact that the section of the bill (H. R. 1714) which became Section 38 of the Consolidated Patent Act of 1870 contained, when introduced, no words enclosed in brackets, nor any words printed in italics, as well as from the statement of the chairman of the Committee on Patents when reporting the bill, that Congress in passing Section 38 did not intend to change the substantive law on the "marking" of patented articles then in force; and it is clear that the change in the phraseology from Section 13 of the Act of 1861 to that of Section 38 of the Act of 1870 merely represented a restatement, by the commissioners on revision, of the law as expressed in

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[1] Congressional Globe, Vol. 43, Part 5, pp. 2679-2680; see appendix, pp. 26 and 27.

[2] Congressional Globe, Vol. 43, Part 5, page 2680; see appendix page 27.

Section 13 of the then existing Act of 1861, which, it is to be noted, was specifically limited to "cases where an article *is* made or vended."

In addition to the foregoing, further facts indicating that Section 38 of the Act of 1870 (Section 4900 R. S.) was not intended by Congress to modify the law as expressed in Section 13 of the Act of 1861, are:

(a) The marginal side-note of Section 38, namely, "2 Mar., 1861, ch. 88 § 13, v. 12, p. 249", is a reference to Section 13 of the Act of 1861; and the Act of 1866 for revision of the laws placed upon the Commissioners of Revision the duty to provide "side-notes" giving "references to the original text from which each section is compiled".[1]

(b) In both the first and second editions of the Revised Statutes the marginal side-note of Section 4900 R. S. cites, as decisions explaining the section, *Rubber Co.* v. *Goodyear,* 9 Wall. 788; and *Goodyear* v. *Allyn,* 6 Blatch. 33. In both of these cases there had been no making or vending of the patented article; and both cases were decided under the 13th Section of the Act of March 2, 1861, which is expressly limited in its application to "cases where an article is made or vended". Under the Act of 1866 it was the duty of the Commissioners of Revision to cite, as side-notes, "decisions of the federal courts explaining or expounding" the law.[2]

Of the two possible interpretations of Section 4900 R. S., the one that should be adopted is that which is in harmony with the intent of Congress, which was, as the legislative history of the statute discloses, merely to provide that in case the patentee *did* make or vend the patented article and failed to fix upon it the required statutory "notice to the public that the same is patented", he should give actual notice of the patent to the infringer before damages for infringement could be recovered. Moreover, such an in-

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[1] See section 2 of Act of 1866; appendix, p. 24.

[2] See note 1.

terpretation, whereby the duty of giving actual notice of the patent is not cast upon the patentee who does not make or vend under the patent, is consistent with the holding by this Court in *Sessions* v. *Romadka*, 145 U. S. 29, 50, that the recordation in the Patent Office of letters patent, with their specifications, is "a record which is notice to all the world."

CONCLUSION.

The granting of a writ of certiorari in this case is peculiarly appropriate. The question is one upon which considerable diversity of opinion exists, and it is of wide importance, affecting the rights of the great majority of all patentees. The existing uncertainty as to the proper interpretation of Section 4900 of the Revised Statutes would be removed by a decision of this Court in this case.

WHEREFORE, it is respectfully prayed that a writ of certiorari should issue.

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Attorneys for Petitioner.

APPENDIX.

Act of June 27, 1866.

Statutes at Large, Chapter 140, v. 1, p. 74
(14 Stat. L. v. 1, 74)

"An Act to provide for the Revision and Consolidation of the Statute Laws of the United States.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the President of the United States be, and he is hereby, authorized, by and with the advice and consent of the Senate, to appoint three persons, learned in the law, as commissioners, to revise, simplify, arrange, and consolidate all statutes of the United States, general and permanent in their nature, which shall be in force at the time such commissioners may make the final report of their doings.

Sec. 2. *And be it further enacted,* That, in performing this duty, the commissioners shall bring together all statutes and parts of statutes which, from similarity of subjects, ought to be brought together, omitting redundant or obsolete enactments, and making such alterations as may be necessary to reconcile the contradictions, supply the omissions, and amend the imperfections of the original text; and they shall arrange the same under titles, chapters, and sections, or other suitable divisions and sub-divisions, with head-notes briefly expressive of the matter contained in such divisions; also with side-notes, so drawn as to point to the contents of the text, and with references to the original text from which each section is compiled, and to the decisions of the federal courts, explaining or expounding the same, and also to such decisions of the State courts as they may deem evpedient; and they shall provide by a temporary index, or other expedient means, for an easy reference to every portion of their report.

Sec. 3. *And be it further enacted,* That when the commissioners have completed the revision and consolidation

of the statutes, as aforesaid, they shall cause a copy of the same, in print, to be submitted to Congress, that the statues so revised and consolidated may be re-enacted, if Congress shall so determine; and at the same time they shall also suggest to Congress such contradictions, omissions, and imperfections as may appear in the original text, with the mode in which they have reconciled, supplied and amended the same; and they may also designate such statutes or parts of statutes as, in their judgment, ought to be repealed, with their reasons for such repeal.

Sec. 4. *And be it further enacted,* That the Commissioners shall be authorized to cause their work to be printed in parts, so fast as it may be ready for the press, and to distribute copies of the same to members of Congress, and to such other persons, in limited numbers, as they may see fit, for the purpose of obtaining their suggestions; and they shall, from time to time, report to Congress their progress and doings.

* * * * * * * * * * *

Approved June 27, 1866."

(*Note:* Sections 5 and 6 relate respectively to the time for completion and to the expense of the work.)

Act of March 2, 1861, ch. 88, § 13; 12 Stat. L. 249.

"Sec. 13. *And be it further enacted,* That in all cases where an article is made or vended by any person under the protection of letters-patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word patented, together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters-patent by the party failing so to mark the article the right to which is infringed upon, no damage

shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented. And the sixth section of the act entitled 'An act in addition to an act to promote the progress of the useful arts,' and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be and the same is hereby repealed."

Act of July 8, 1870, ch. 230, § 38, 16 Stat. L. 203.

"Sec. 38. *And be it further enacted,* That it shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented either by fixing thereon the word 'patented', together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use or vend the article so patented."

Congressional Globe,
Vol. 43, Part 5, at pages 2679 and 2680.

"PATENT AND COPYRIGHT LAWS.

Mr. JENCKES, from the Committee on Patents, reported back with amendments, and with the recommendation that it do pass, the bill (H. R. No. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights.

Mr. JENCKES. Mr. Speaker, if the House will indulge me I think they will obtain a sufficient idea of what is proposed by this bill from a statement in explanation of its provisions without reading it in full.

The bill now reported from the Committee on Pat-

ents is based upon the revision of the laws relating to patents and copyrights made by the commissioners of revision appointed under the statute authorizing a revision of the laws of the United States. That revisal of these particular statutes was reported to this House early in this Congress and referred by the House to the Committee on the Revision of the Laws of the United States. It was examined by that committee and was found to embody all the provisions of existing law, in brief, clear, and precise language. They subsequently reported it to the House and recommended that it be referred to the Committee on Patents.

In prospect of this proposed revision, the Committee on Patents had already received numerous communications from those interested in the subject, and also numerous bills and petitions that had been filed in the House and referred to that committee, proposing various amendments to the existing laws. They had taken all these into consideration and invited the presence of persons interested in the different subjects to which the amendments were intended to apply, and encouraged discussion from those interested and from those learned in this branch of the laws upon those proposed amendments. They were heard at great length, and the committee were very careful to give a hearing, either orally or by written communication, to any and every person who supposed that there were defects in the existing laws which ought to be remedied, or who could make plain and clear the practice under the laws so as to secure more perfectly the rights which these laws were intended to protect. The result of all these hearings and discussions has been the adoption by the committee of certain propositions of amendment to these laws, which they have embodied in the bill now before the House.

The bill is so printed as to show the law exactly as it now is, in the form in which it came from the hands of the commissioners of revision. Every provision which is now in force has been printed at length in the bill, although it is proposed to strike out by way of amendment many of them. All those which it is proposed to strike out are printed, and the amend-

ments, many of which are substitutes for the parts proposed to be omitted, are also printed separately, and in italics, so that they may be clearly distinguished from the law as it now is. The House, therefore, now have before them in the reported bill the exact state of the law, those provisions of the law which it is recommended shall be dropped, and of the new provisions which shall be substituted in their place, and also of the minor amendments which are proposed to different parts of the bill. It can be seen, therefore, at once what has been the law, what is the law, in what respects the existing law is supposed to be defective, how that defect is proposed to be amended, and how the law will read if the amendment should be adopted.

Having thus stated the history of the bill, and the state in which it is presented to the House, I will consider the general provisions of the act, without at the present time going into details."